

***Remarks***

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendments, Claims 1-28 are pending in the application, with Claims 1 and 26 being the independent claims. Claims 1, 5 and 22 have been amended. Support for the subject matter of the amended claims is contained in the application as originally filed. Because the foregoing changes introduce no new matter, their entry is respectfully requested.

Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Reissue Applications***

Applicants note the Examiner's requirement for the original patent, or a declaration as to loss or accessibility as well as a supplemental reissue oath/declaration. Applicants respectfully submit that the necessary documents will be filed in due course.

The Examiner has rejected Claims 1-28 under 35 U.S.C. § 251 as being based upon new matter. Applicants respectfully traverse the Examiner's rejection for the same reasons as set forth below with regard to the Examiner's rejection of claims 1-28 under 35 U.S.C. § 112, first paragraph.

***Claim Objections***

The Examiner objected Claim 5 as being of improper dependent form for failing to limit the subject matter of a previous claim. Applicant respectfully traverses the Examiner's objection because Claim 5 does in fact further limit the limitations of Claim 9 from which it depends. Although the dependency of the claims are sequentially out-of-order, that is Claim 5 is dependent upon Claim 9 instead of the reverse, the numbering is proper because the original numbering of the claims must be preserved throughout prosecution in accordance with 37 C.F.R. § 1.126. Nonetheless, the limitations of Claim 9 have been incorporated into the Claim 5 in the interest of expediently overcoming the Examiner's objection. Applicant notes that this amendment was

made solely to overcome the Examiner's objection and should not be construed as being related to patentability, that is, to the statutory requirements for a patent.

***Rejections under 35 U.S.C. § 112***


***Claims 1-28***

The Examiner has rejected Claims 1-28 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner considers the limitation "a plurality of scorelines" and the limitation "positioned on the bottom" as new matter. Applicants respectfully traverse the Examiner's rejection of Claims 1-28.

As noted in Applicants' previous AMENDMENT AND REPLY UNDER 37 C.F.R. § 1.111 dated October 10, 2000, difference between the new claims and the corresponding original claims of U.S. Patent No. 5,687,865 ("the '865 patent") is that the new claims call for a cap having "at least one scoreline". *See, e.g.*, Claim 1, line 8. The Examiner's position is that the '865 patent does not provide support for a plurality of scorelines. *See* Office Action dated November 27, 2000, page 4, lines 5-6. The Examiner correctly considers the new claims to read on caps having a plurality of scorelines in addition to caps having just one scoreline, however, the Examiner improperly considers the original claims to read only on caps having just one scoreline. *Id.*

Applicants respectfully submit that the limitation "a scoreline" found in the claims of the '865 patent does not precludes a plurality of scorelines but instead encompasses one or more scorelines. *See KCJ Corp. v. Kinetic Concepts, Inc.* 55 USPQ2d 1835, 1838-40 (Fed. Cir. 2000)(The Federal Circuit "has repeatedly emphasized that an indefinite article 'a' or 'an' in patent parlance carries the meaning of 'one or more' in open-ended claims containing the transitional phrase 'comprising.')(citing *Elkay Manufacturing Co. v. Ebco Manufacturing Co.*, 52 USPQ2d 1109, 112 (Fed. Cir. 1999)("The asserted claims, however, use the open term 'comprising' in their transitional phrases. We therefore hold that the plain meaning of 'an upstanding feed tube...' is not necessarily limited to a single feed tube...."). In accordance with

the general rule acknowledged by the Federal Circuit, the claim limitation “a scoreline” found in the claims of the ‘865 patent encompasses one or more scorelines and thus can also be interpreted as “at least one scoreline”. *See KCJ Corp.*, 55 USPQ2d at 1839 (“Under this conventional rule, the claim limitation ‘a,’ without more, requires *at least one*.” (emphasis added)). The amendment to Claim 1 merely explicitly states that the scope of the claims encompasses a cap having, *inter alia*, one or more scorelines, a feature which, in accordance with the general rule discussed above, is found in the issued claims of the ‘865 patent.

 The Examiner has taken the position that the specification fails to teach any option of providing more than one scoreline. *See* Office Action dated November 27, 2000, page 6, third whole paragraph. Applicants respectfully disagree because, standing alone, a disclosure of a preferred or exemplary embodiment encompassing a singular element, for example, a singular scoreline does not disclaim a plural embodiment, in this case, a plurality of scorelines. *KCJ Corp.*, 55 USPQ2d at 1839 (“[S]tanding alone, a disclosure of a preferred or exemplary embodiment encompassing a singular does not disclaim a plural embodiment.”) Instead, “[t]he general rule ... is that the claims of a patent are not limited to the preferred embodiment, unless by their own language.” *Elkay*, 52 USPQ2d at 112. In this case, Applicant is not limited to a single scoreline because the preferred embodiments of the invention disclosed have a single scoreline. *KCJ Corp.*, 55 USPQ2d at 1839.

The Examiner has also taken the position that the specification fails to teach how to incorporate more than one score line in the well that would render it self-closing. *See* Office Action dated November 27, 2000, page 6, third whole paragraph. Applicant respectfully submits that such position is moot because the claims of the present application, as well as the claims of the ‘865 patent, do not recite such a feature.

Another difference between the new claims and the corresponding original claims of the ‘865 patent is that the new claims call for a cap having at least one scoreline “positioned on [the] bottom” of a well of the cap. *See, e.g.*, once amended Claim 1, lines 8-9. The Examiner has taken the position that the prior patent does not provide support for a scoreline positioned only on said bottom. *See* Office Action, page 4, lines 4-5. In this regard, Examiner notes that the specification, that is, the disclosed preferred embodiments teach that the score line comprises

three stretches. *See* Office Action, page 6, third whole paragraph.

Applicants respectfully submit that it is a general rule that the claims of a patent are not limited to the preferred embodiment disclosed in the specification. *Elkay*, 52 USPQ2d at 1112 (quoting *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 50 USPQ2d 1465, 1469 (Fed. Cir. 1999)). In fact, it has long been held that inventors are not required to limit their claims to a specific example or examples disclosed in their application but are entitled to claim their invention as broadly as the prior art permits. *Beale v. Schuman*, 212 U.S.P.Q. 291, 293-94 (Bd. Pat. App. & Int. 1980)(“[A]n applicant in a mechanical case is allowed claims, when the art permits, which cover more than the specific embodiments shown.”)(citing *In re Moore*, 169 U.S.P.Q. 236 (C.C.P.A. 1971)). In the present application, Applicants respectfully submit that the first stretch 52 and the third upward stretch 54 described in the patent specification are only part of an embodiment of the invention and are not *necessary* for the insertion of probe 61 through scoreline 51. Accordingly, Applicants are entitled not only to claims directed to caps having a scoreline extending along a side wall and across the bottom of the well, but are also entitled to claims directed to caps that have a scoreline positioned on a bottom of the well of the cap, unless of course, the prior art prevents such claims. Accordingly, Applicants submit the limitation “one score line positioned on said bottom” is not new matter.

For at least these reasons, Applicants respectfully submit that claims 1-28 do not contain new matter and respectfully request the Examiner to withdraw the rejection under 35 U.S.C. §112, first paragraph.

Should the Examiner maintain the rejection of Claims 1-28 under 35 U.S.C. §112, first paragraph, Applicants again respectfully request citation of authority in support of the Examiner’s position.

### ***Claims 22***

Applicant respectfully submits that the Examiner’s rejection of Claim 22 on the basis that “said side well” lacks antecedent is overcome by the accompanying amendment thereto.

***Rejections under 35 U.S.C. § 102******Claims 1, 2, 5, 9, 15 and 16***

The Examiner has rejected Claims 1, 2, 5, 9, 15 and 16 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,022,258 to Steidley ("the Steidley patent"). The Steidley patent not only lacks the cap of the present invention including a central well having at least one scoreline positioned on a bottom and a side wall formed to cause a probe having a blunt tip to engage said bottom at a center thereof as the probe is forced into said well, but also fails to position the scoreline such that the probe splits said bottom along said scoreline as the blunt tip of the probe is forced against said center of said bottom, as is called for by amended Claim 1.

The Steidley patent does not disclose a cap including a well having a scoreline which is split by a probe having a blunt tip nor does the Steidley patent disclose, teach or suggest a side wall formed to cause such a probe to engage a center portion of a bottom of the well. Instead, the Steidley patent discloses a ported closure having a bottom wall with a dome-shaped upper surface which facilitates proper positioning and cutting action of a cooperating piercing spike that engages a perimeter of the bottom wall. See column 2, lines 20-22; FIGS. 2 and 3. Namely, dome-shaped bottom wall 15 properly positions an angular cutting edge 25 of spike 23 such that it pierces bottom wall 15 along its perimeter in a manner that results in the formation of a flap which is pushed aside but not detached from the closure. See column 2, lines 28-33.

In contrast, the cap of the present invention directs a blunt tip of a probe toward a center of a well bottom as it is forced into the well in order to split the well without the need for a cutting edge. See FIG. 5. In this regard, the claimed invention includes a well 46, a scoreline 51 positioned on a bottom 48 of the well, and a side wall, for example, conical side 47, which formed to cause a dispenser probe 61 having a blunt tip 62 to engage bottom 48 at a center thereof as probe 61 is forced into the well. Scoreline 51 is positioned such that blunt tip 62 of probe 61 splits bottom 48 along scoreline 51 as blunt tip 62 is forced against the center of bottom 48. See FIG. 5.

For at least these reasons, Applicant respectfully submits that the Steidley patent does not anticipate presently amended Claim 1. Applicant submits that Claims 2, 5, 9, 15 and 16, which depend from Claim 1, are allowable over the cited art for at least the same reasons noted above.

***Double Patenting******Claims 1, 3-14, 19 and 20***

The Examiner has rejected Claims 1, 3-14, 19 and 20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-12 of U.S. Patent No. 5,513,763 to Adams *et al.* ("the '763 patent") in view of U.S. Patent No. 4,173,858 to Cassia ("the Cassia patent"). Not only do the '763 patent and the Cassia patent fail to teach or suggest the cap of the present invention including a central well having at least one scoreline positioned on a bottom and a side wall formed to cause a probe having a blunt tip to engage said bottom at a center thereof as the probe is forced into said well, the patents also fail to teach or suggest positioning the scoreline such that the probe splits said bottom along said scoreline as the blunt tip of the probe is forced against said center of said bottom, as is called for by amended Claim 1.

The '763 patent fails to disclose well having such a scoreline. Instead, the '763 patent discloses a discrete plug 51 which is selectively pushed out of well 46.

The Cassia patent, similar to the Steidley patent discussed above, likewise does not disclose such a scoreline which is split by a probe having a blunt tip nor does the Cassia patent disclose, teach or suggest a side wall formed to cause such a probe to engage a center portion of a bottom of the well. Instead, the Cassia patent discloses a plug having a bottom closure wall which is pierced by a cooperating piercing member that engages a perimeter of the bottom closure wall. See column 6, lines 59 *et seq.*; FIG. 9. Namely, plug 160 properly positions sharp point 139 of piercing member 130 such that it pierces bottom closure wall 170 along its perimeter along annular recess 171 in a manner that results in the formation of a flap which is pushed aside but not detached from the closure. See column 7, lines 5 *et seq.*

In contrast and as noted above, the cap of the present invention directs a blunt tip of a probe toward a center of a well bottom as it is forced into the well in order to split the well without the need for a cutting edge. See FIG. 5.

For at least these reasons, Applicant respectfully submits that the '763 and the Cassia patents to not render presently amended Claim 1 obvious. Applicant submits that Claims 2, 5, 9,

15 and 16, which depend from Claim 1, are allowable over the cited art for at least the same reasons noted above.

***Other Matters***

Applicants respectfully note that Claims 17, 18 and 21-28 have not been rejected anticipated nor obvious over the prior art of record. Accordingly, Applicants respectfully submit that Claims 17, 18 and 21-28 are allowable upon withdrawal of the Examiner's new matter rejection of Claims 1-28 under 35 U.S.C. §112, first paragraph.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, the personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extension of time or additional claims, and/or credit any overpayment to Deposit Account No. 06-1300 (Order No. RI-61182/RBC/VEJ).

PATENT

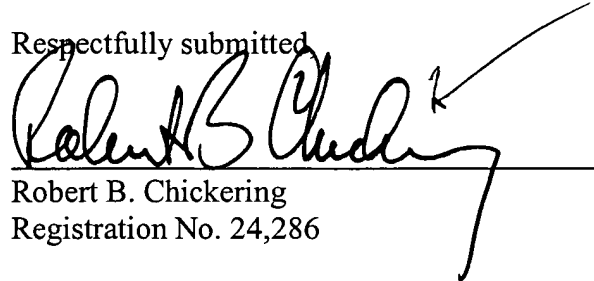
RI-61182/RBC/VEJ  
Application No. 09/375,164

Prompt and favorable consideration of this Amendment and Response is respectfully requested.

Date:

4/27/01

Respectfully submitted

A handwritten signature in black ink, appearing to read "Robert B. Chickering", is written over a horizontal line. A long, sweeping flourish extends from the end of the signature.

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